

### **REMARKS**

Claims 1-37 and 39-46 are now pending in the application. Claim 38 has been cancelled by this amendment. Claims 1-36 are withdrawn from consideration, without disclaimer to the subject matter therein. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

The Applicant is filing herewith an Information and Disclosure Statement noting co-pending U.S. Patent Application 10/686,236.

### **REJECTION UNDER 35 U.S.C. § 103**

Claims 37-46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Clark et al. (U.S. Pat. No. 5,266,075) in view of Howell et al. (U.S. Pat. No. 5,674,224). This rejection is respectfully traversed.

Clark et al. discloses a tendon threader 10 including a hollow tube 11 that is to be positioned through a straight tunnel. Clark et al. teaches that the hollow tube 11 is slid into a straight ligament tunnel 33 by a surgeon observing the patient's knee with a fluoroscopic monitor or by utilizing an arthroscope or the like. In particular, Clark et al. discloses that an arthroscope 41 can be fitted on the hollow tube 11 to view the end of the threader through the hollow tube 11 to ensure appropriate positioning of the pin 21. Therefore, Clark et al. does not teach using an external guide and specifically teaches away from using an external guide by teaching that a surgeon will observe positioning the pin in a patient's knee using a fluoroscopy monitor or arthroscope. *See*, Col. 5, ln. 30-44. In light of this the Applicant also submits that there is no teaching or suggestion

in the cited art to combine Clark et al. with Howell et al. to suggest each of the elements of presently pending independent Claim 37. Because Clark et al. actually teaches away from or aligning an external guide member with any other portion of the device disclosed in Clark et al. Therefore, Clark et al. cannot be combined with Howell et al. to teach or suggest each of the elements that are presently recited in the Independent Claim 37.

Further, Howell et al. teaches that a hollow suture passing device 130 is used to maneuver through the tibial tunnel so that a loop 132 can be located around a nose 48 of a screw 42. In other words, Howell et al. teaches that the second tunnel is formed **prior** to moving the suture loop around the nose of the screw. Contrary to this Clark et al. teaches that the suture is held on the hollow tube in a first tunnel **while** a second tunnel is being formed. Also, Howell et al. only teaches that an external portion can be used to align positioning a transverse member. Howell et al. does not teach that a portion of the aligning member is used to pass any portion of the suture, graft, or the like.

Further, Howell et al. and Clark et al. could not be combined because the two systems are contrary. Clark et al. teaches using the threader to position a strand and an arthroscope to ensure appropriate positioning of the cross member. While Howell et al. requires that all of the tunnels and cross-members be positioned before a strand or graft is moved through the tunnels. Thus, Clark et al. and Howell et al. could not be reasonably combined.

Therefore, the Applicant submits that independent Claim 37 is in condition for allowance, as are each of the claims that depend directly or indirectly therefrom.

The Applicant further submits that each of the dependent claims include patentable subject matter that is patentable separately from the subject matter recited in independent Claim 37. For example, dependent Claim 42 includes patentable subject matter separate from that of Independent Claim 37 including "forming said transverse tunnel comprises aligning said tool bit to form said transverse tunnel using said insertion rod." Such elements are not taught or fairly suggested by the art of record. Therefore, the Applicant submits that independent Claim 37 is in condition for allowance and the dependent claims that depend directly or indirectly therefrom are allowable because independent Claim 37 is allowable and also because each include subject matter patentable in light of the cited art.

#### **DOUBLE PATENTING**

Claims 37-42 and 46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 16-25 of co-pending Application No. 10/686,236.

Although the double patenting rejection is provisional, to expedite prosecution of the present Application, a Terminal Disclaimer disclaiming the terminal portion of any patent that may issue from the present Application that would extend in term beyond the term of any patent that may issue from the co-pending Patent Application 10,686,236, is filed herewith. It is submitted that this Terminal Disclaimer obviates a double patenting rejection and the Applicant requests that the Examiner withdraw the double patenting rejection.

## CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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